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Commissioner for Patents
United States Patent and Trademark Office
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DIW 01-02

Paper No. 6

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In re Application of :
Bunger, Reiling, Comb, Bank, :
McCaffrey, Reiling, and Velten : DECISION REFUSING STATUS
Application No. 09/822,961 : UNDER 37 CFR 1.47(a)
Filed: 30 March, 2001 :
Attorney Docket No. SFTC-01004US0 :

OFFICE OF PETITIONS

This is in response to the petition filed under 37 CFR 1.47(a) on 3 January, 2002.¹

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified issue application was filed on 30 March, 2001), without an oath or declaration. Accordingly, on 8 May, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an

¹A duplicate copy of the petition and associated papers was received on 8 January, 2002. As applicant was charged the petition fee, surcharge, and extension of time fee twice, the duplicate payments will be refunded to counsel's deposit account, No. 50-1826.

executed oath or declaration and a surcharge for its late filing. In response, on 3 January, 2002 (certificate of mailing date 8 November, 2001), petitioners filed the present petition, accompanied by the petition fee, a request and payment for a four (4) month extension of the time for reply to the aforementioned Notice, the required surcharge, and a declaration naming Mark Bunger, Michael Reiling, Michael Comb, Edward Bank, Michael McCaffrey, Carolee A. Reiling, and Juan Carlos Velten as joint inventors and signed by all inventors except McCaffrey on behalf of themselves and on behalf of joint inventor McCaffrey.

Petitioners state that a letter was mailed to joint inventor McCaffrey at his last known address, asking him to sign the declaration for the present application for patent, but no response was received. Petitioners state that further attempts to locate McCaffrey by telephone and E-mail searches were unsuccessfully.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) and (2). In regards to item (1), petitioners have not shown that a copy of the application papers (specification, including claims, drawings, if any, and the declaration) were sent or given to the nonsigning inventor for review. Although petitioners state that attempts to locate McCaffrey by telephone and E-mail were unsuccessful, the letter sent to him was not returned. A review of the record indicates no irregularity in the mailing of the letter to McCaffrey, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. Therefore, petitioners must show that a copy of the application as filed was sent to McCaffrey.

Petitioners may show proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor for review² by providing a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal can be alleged, petitioners must show that a copy of the application as filed was sent or given to the non-signing inventor. If there is a written refusal, petitioners should supply a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), the declaration filed with the present petition is defective in that it does not state that the person(s) making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person(s) to be material to patentability as defined in 37 CFR 1.56. Rather, the declaration incorrectly acknowledges a duty to disclose all information material to examination of the application. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67 is required with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

²See MPEP 409.03(d).

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Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

A handwritten signature in cursive script, appearing to read "D Wood".

Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy